UNITED STATES PATENT AND TRADEMARK OFFICE

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10/687,617	10/20/2003	Katsuhiko Akiyama	1405.1077	2603

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 November 2007_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-2 and 3-8_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-2 and 3-8_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _10/20/03_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _11/30/07_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: A request for continued

examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was

filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the finality of the previous Office action has been withdrawn pursuant to 37

CFR 1.114. Applicant's submission filed on 11/30/07 has been entered.

2.   Claims 1-2 and 4-8 are currently pending in the case, with claims 1, 6, and 7

being the independent claims. Claims 1-2 and 4-8 are rejected.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 1-5 are considered software per se.

Computer programs may be explicitly claimed as, for example, a series of code or

instructions for performing functions or may be implicitly claimed as, for example, a

system, a module or an apparatus. Where there is no evidence in the specification that

a means which may be interpreted as software, hardware or combinations thereof

necessarily includes hardware, it will be interpreted in its broadest reasonable sense as

a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per

se, is not patent eligible subject matter. It should be noted that functional descriptive

material claimed in combination with an appropriate computer readable medium to

enable the functionality to be realized is patent eligible subject matter if it is capable of

producing a useful, concrete and tangible result when used in the computer system.

Claim Objections

5.   Claims 1-2 and 4-8 are objected to because of the following informalities: The

claims have been amended to recite ". . .merging with said displayed web page when

said URL is among URL's stored in said storage". However, the claim appears to be

missing language specifying what is merged with the displayed web page. Appropriate

correction is required.

Claims Rejection – 35 U.S.C. 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claims 1-2, 4, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla, et al., (U.S. Patent 5,146,552, issued September 8, 1992) [hereinafter "Cassorla"], in view of Montlick, (U.S. Patent 5,561,446, issued October 1, 1996) [hereinafter "Montlick"], Hollstrom et al., US 2001/0033293 A1, 10/25/01 (provisional application filed 02/16/00), and Applicant Admitted Prior Art (AAPA), Specification pages 7-8.

Regarding **independent claim 1, as amended**, Cassorla in view of Montlick teaches:

> *A document browser that merges and displays additional information with document data, including text data and/or image data, that can be displayed on a display device, comprising:*

> *an additional information input judgment means judging whether handwriting input is enabled at a location;*

> *additional information receiving means for receiving input of the additional information that includes handwritten pen-track data;*

(See, Cassorla, col. 2, lines 23-25, teaching that than annotation ("additional information") may be stored within or separately from the published material.)

> *positional information obtaining means for obtaining the positional information of the additional information in the document data;*

(See, Cassorla, col. 2, lines 41-44, teaching the use of relative position to fix the precise position of some annotations that the reader wants to pinpoint to a particular line or word position.)

> *properties information obtaining means for obtaining properties information of the additional information; said properties information including attribute information included in the additional information including line color, level of transparency, and line thickness or other properties data of the additional information such as a shape classification, size, or date and time of input.*

(See, Cassorla, col. 4, lines 4-42, teaching a variety of properties that may be attached to annotations, including color, type style, etc. See also, Cassorla, col. 5, lines 18-21, teaching that once the reader has completed adding the additional information, the invention adds the topic, line number, author identification, date and time information to the text of the note.)

> *additional information storage means for storing the additional information that includes handwritten pen-track data with the positional information and the properties information;*

(See, Cassorla, col. 5, lines 21-24, teaching storage of notes ("additional information") in a file or partition of a file on a host system or as a separate file on the local disk of a stand-alone workstation or personal computer.)

> *additional information searching means for searching the additional information stored in the additional information storage means based on the properties information of the additional information; and*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.)

> *search results display means for displaying on the display device the search results found by the additional information searching means.*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.

Cassorla does not expressly teach *handwritten pen-track data* or *a handwriting pen-track identification part using pattern recognition technology to identify a kind of shape classification for pen-track data input using the pointing device.*

Montlick teaches "handwritten pen-track data" as "electronic ink." Specifically, Montlick teaches receiving, displaying, and storing electronic ink as additional information to text and graphics. See, Montlick, col. 2, line 37 through col. 12, line 4, specifically see, col. 9, lines 26-37, and col. 10, line 6 through col. 11, line 18, teaching associating electronic ink with annotations. Further it is noted that in order to receive, display, and store the handwriting input, it is required that the input be "enabled"; otherwise handwriting input could not be input in the first place.

The teachings of Cassorla and Montlick are combinable in that that both involve the art of electronic annotation of text and graphics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Cassorla and Montlick.

The suggestion or motivation to combine the references is that Cassorla teaches "notes" as textual annotations to a document. See, Cassorla, col. 4, line 55 through col. 5, line 30, teaching "notes" as annotations. Montlick teaches a handwritten, electronic ink, method of incorporating notes into an electronic document. Therefore Montlick merely adds another function, handwritten notes, to the typed notes taught by Cassorla. They are just different forms of entry for notes or annotations associated with a document. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick to result in the invention specified in claim 1.)

While neither Cassorla nor Montlick teach *a browsing part reading a Uniform Resource Locator (URL) of a displayed web page and its associated pen-track data from storage and merging with said displayed web page when said URL is among URL's stored in said storage,* Hollstrom does. Hollstrom teaches the electronic pen client can detect the URL of an application description. If the URL is found, then the name server sends the information to the pen client. See page 4, paragraphs [0038]-[0039].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Hollstrom's searching of the URL and its pen track data from storage into the system of Cassorla/Montlick because there was a need at the time of the invention to improve the capabilities of applications for accepting input from users by expanding the mechanisms supporting user interaction. See page 1, paragraphs [0005]-[0007].

While neither Cassorla, Montlick, nor Hollstrom teaches *a handwriting pen-track*

identification part using pattern recognition technology to identify a kind of shape

classification for pen-track data input using the pointing device, AAPA teaches on page

7, lines 24-27 and page 8, lines 1-16 of the Specification, "Pattern recognition

technology that judges which shape a pattern best matches has long been known, and

detailed description of that technology will be omitted here". Therefore, the newly

recited limitation was well known in the art at the time of the Applicant's invention as

indicated by Applicant's specification on pages 7-8. It would have been obvious to a

person of ordinary skill in the art at the time of the invention to include a handwriting

pen-track identification part to identify the shape of pen-track data in the system of

Cassorla/Montlick/Hollstrom because it aids in judging what shape a pattern best

matches.

Regarding **dependent claim 2**, Cassorla in view of Montlick teaches:

> *The document browser according to claim 1, wherein the document data*
>
> *is an HTML document, an XML document, or other structured document.*

(See, Cassorla, col. 1, lines 12-66, teaching that the invention may be used with a

structured document, including a markup language source document, and also including

a document in the standardized general markup language (SGML).)

Regarding **dependent claim 4**, Cassorla in view of Montlick teaches:

>The document browser according to any of the claims 1, wherein the
>
>additional information receiving means comprises a pen tablet, a mouse, or other
>
>pointing device.

(See, Cassorla, col. 3, line 12 through col. 4, line 3, teaching use of an appropriate

action with a pointing mechanism such as a text or graphic cursor driven by a mouse,

touch screen, joystick, keyboard or other command action, which is the same as the

means claimed in the application.)

Regarding **independent claim 6, as amended**, Cassorla in view of Montlick teaches:

>A document browsing method in which additional information is merged
>
>and displayed with document data, including text data and/or image data, that
>
>can be displayed on a display device, comprising:
>
>displaying the document data on a display device;
>
>judging whether handwriting input is enabled at a location;
>
>receiving an input of additional information, including handwritten pen-
>
>track data, with respect to the document data displayed on the display device;
>
>reading a URL of a displayed web page and its associated pen-track data
>
>from storage and merging with said displayed web page when said URL is
>
>among URL's stored in said storage;
>
>obtaining the positional information of the additional information in the
>
>document data;

obtaining properties information of the additional information, said

properties information including attribute information included in the additional

information including line color, level of transparency, and line thickness or other

properties data of the additional information such as a shape classification, size,

or date and time of input.

storing the additional information that includes handwritten pen-track data

with the positional information and the properties information;

searching the additional information stored in the additional information

storage means based on the properties information of the additional information;

and

displaying on the display device the search results found by the additional

information searching means;

identifying, via pattern recognition technology, a kind of shape

classification for pen-track data input using the pointing device.

(Claim 6 incorporates substantially similar subject matter as claimed in claim 1 and is

rejected along the same rationale.)

Regarding **independent claim 7, as amended**, Cassorla in view of Montlick teaches:

A computer readable medium encoded with processing instructions for

causing a processor to execute a document browsing method, the document

browsing method merging and displaying additional information with document

data, including text data and/or image data, that can be displayed on a display

device, and comprising:

displaying the document data on a display device;

judging whether handwriting input is enabled at a location;

receiving the additional information, including handwritten pen-track data,

input to the document data displayed on the display device;

reading a URL of a displayed web page and its associated pen-track data

from storage and merging with said displayed web page when said URL is

among URL's stored in said storage;

obtaining the positional information of the additional information in the

document data;

obtaining properties information of the additional information, said

properties information including attribute information included in the additional

information including line color, level of transparency, and line thickness or other

properties data of the additional information such as a shape classification, size,

or date and time of input.

storing the additional information that includes handwritten pen-track data

with the positional information and the properties information;

searching the additional information stored in the additional information

storage means based on the properties information of the additional information;

and

> *displaying on the display device the search results found by the additional*
>
> *information searching means; and*
>
> *identifying, via pattern recognition technology, a kind of shape*
>
> *classification for pen-track data input using the pointing device.*

(Claim 7 incorporates substantially similar subject matter as claimed in claim 1 and is

rejected along the same rationale.)

8.   **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla

in view of Montlick, Hollstrom et al., US 2001/0033293 A1, 10/25/01 (provisional

application filed 02/16/00), and Applicant Admitted Prior Art (AAPA) as applied to claim

1 above, and further in view of Fitzpatrick, et al., "Translucent Window Attribute," IBM

Technical Disclosure Bulletin, Vol. 36, No. 06A, pages 135-136, June 1, 1993

[hereinafter "Fitzpatrick"].

Regarding **dependent claim 5**, Cassorla in view of Montlick and further in view of

Fitzpatrick teaches:

> *The document browser according to any of the claims 1, wherein the*
>
> *additional information is displayed semi-transparently so that the document data*
>
> *is identifiable when the additional information is merged with the document data.*

(Cassorla in view of Montlick teaches the invention of claim 1, but does not expressly

teach that the additional information is displayed semi-transparently so that the

document data is identifiable when the additional information is merged with the document data.

Fitzpatrick expressly teaches a "translucent window," which is used when a container object is located on top of other container objects.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick for the association of annotations with a document, with the teachings of Fitzpatrick that a window containing the annotation could be placed on top of the text, with the annotation displayed semi-transparently or translucently.

The suggestion or motivation to combine the references is expressed in Fitzpatrick which states that the translucent window attribute greatly expands the number of objects accessible by users for a given presentation space. Rather than forcing a note to occupy a column of a display screen, overlaying a note over a document in a translucent form prevents obstruction of the underlying document and thus greatly expands the number of objects accessible to the user for a given presentation space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla and Montlick with the teachings of Fitzpatrick to result in the invention specified in claim 5.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Hollstrom et

al., US 2001/0033293 A1, 10/25/01 (provisional application filed 02/16/00),

Regarding claim 8, Hollstrom discloses an electronic help feedback and

information retrieval system for displaying feedback in a device. Hollstrom teaches the

electronic pen client receives action requests from the pen and responds to those

requests as data is received which meets the limitation, **determining when contents of**

a web page being displayed change. See page 2, paragraphs [0026]-page 3,

paragraphs [0030]. Hollstrom teaches the electronic pen client can detect the URL of

an application description in storage which meets the limitation, **searching to**

determine whether a Uniform Resource Locator (URL) of the displayed web page

is located in storage. See paragraphs [0038]-[0039]. If the URL is found, then the

name server sends the information to the pen client after a get application description

procedure and loads the application which meets the limitation, *reading said URL and*

its associated pen-track data from the storage, merging with the displayed web

page, and displaying a result of said merging. See paragraphs [0038]-[0039].

11.   It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the references should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Response to Arguments

12.   Applicant's further amendments and arguments filed 11/30/07 have been fully

considered.

On page 6 of the Remarks, Applicant provides an overview of the teachings of

the prior art references, Cassorla and Montlick.

On page 7 of the Remarks, Applicant argues none of the prior art references

teach reading a URL of a displayed web page and its associated pen-track data from

storage and merging in a manner identified in the present invention. Applicant's

amendment necessitated the new ground(s) of rejection presented in this Office action

above. Specifically, Hollstrom, US 2001/0033293 A1 has been utilized to teach the

feature of reading a URL of a displayed web page and its pen track data from storage

and merging it with document data. Please refer to the rejection above.

In view of the comments above, the rejection is maintained.

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rachna Singh whose telephone number is 571-272-

4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Rachna Singh
01/17/08